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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/308,005 05/10/99 BENNETT N 2703/FBR

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SEVEN BECKER FARM ROAD  
ROSELAND NJ 07068

QM12/1119

EXAMINER

TRINH, M

ART UNIT	PAPER NUMBER
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3729

DATE MAILED:

11/19/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/308,005

Applicant(s)

BENNETT

Examiner

MINH TRINH

Group Art Unit

3729



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 9-27 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 9-27 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

1. The disclosure is objected to because of the following informalities: misspelling "utilizing" in page 3 line 20. Appropriate correction is required.

2. Applicant is requested to review the specification and claims and amend them to be consistent with U.S. practice.

3. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

4. The numbering of claims is not accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 1-19 been renumbered 9-27.

5. Claims 10-16, 18-21 and 23-27 line 1, "A gaming machines " should be "The gaming machine"

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6. Claims 9-27 are objected to because of the following informalities:

Claims 19, 21, 22 , line 1 misspelling “gaming “; Claim 18, in page 5, line 2 misspelling “adapted “ and many other has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors is required.

The “wild indicia” in claim 14, and the “wild ball” in claims 18 -19 are they representing the same element structure ?.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 9-27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The scope of claim 9-27 are not clear. The claims appear to be directed to a gaming machine. However, all the elements that make up the invention has not been recited. All of the element structure that make up the machine must be clearly and positively recited and structurally interrelated in such manner as to present a complete and operative machine. For example claim 1, “ a gaming machine having--- “ no positive element structure recite in this claim, claim 1, page 2, line 4 “those indicia” is unclear and confusing at what applicant referring to

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as a series of indicia or a group of indicia or a player indicia; claim 1, line 6-7 the phrase "predetermined number of matches of the player's indicia----control means occur" is awkwardly worded and confusing; Furthermore, the machine comprising; further comprising and wherein consisting etc.. These elements structure are not recited in the above claims. While an application can be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

10. Claims 9-13, 14-18, 22-27 are rejected under 35 U.S.C. 102(b) as being anticipated by DIRE ET AL (US 4,756,531) or LEAKE (US 5,624,119) or MARGOLIN (US 5,813,911) or KRAVITZ ET AL (US 5,545,088).

DIRE ET AL discloses a gaming machine having a display means 15, 16 , and a game control means 12 arranged to control images displayed on the display means (fig 1, col 7, lines 45-55) , the game control means 12 being arranged to play a game in which a player makes a

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selection of a series of indicia chosen from a larger group of indicia (col 3, lines 1-68) , that selection defining the player's selected indicia, the game control means 12 being arranged to generate a series of indicia drawn at random from the larger group of indicia (col 3-col 4), the display means being adapted to display in a predetermined location. The indicia which have been generated by the game control means for comparison with the player's selected indicia with prize being awarded if more than a predetermined number matches of players selected indicia (col 9, lines 34-68, col 10 , lines 20-67).

11. Claims 9-13, 15-17, 22-27 are rejected under 35 U.S.C. 102(e) as being anticipated by MARGOLIN (US 5,813,911) or KRAVITZ ET AL (US 5,545,088).

MARGOLIN discloses a gaming machine having a display means 10 , and a game control means 20 arranged to control images displayed on the display means (col 4, lines 24-67) , the game control means 20 being arranged to play a game in which a player makes a selection of a series of indicia chosen from a larger group of indicia , that selection defining the player's selected indicia, the game control means being arranged to generate a series of indicia drawn at random from the larger group of indicia, the display means being adapted to display in a predetermined location. The indicia which have been generated by the game control means for comparison with the player's selected indicia with prize being awarded if more than a predetermined number matches of players selected indicia (col 3, lines 1-16, col 4, lines 35-67, col 5, lines 1-67, col 6, lines 1-20, col 7-8).

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12. Regarding to claims 9-27, KRAVITZ ET AL discloses a gaming machine having a display means 10 , and a game control means 20 arranged to control images displayed on the display means (col 4, lines 24-67) , the game control means 20 being arranged to play a game in which a player makes a selection of a series of indicia chosen from a larger group of indicia , that selection defining the player's selected indicia, the game control means being arranged to generate a series of indicia drawn at random from the larger group of indicia, the display means being adapted to display in a predetermined location. The indicia which have been generated by the game control means for comparison with the player's selected indicia with prize being awarded if more than a predetermined number matches of players selected indicia (col 3, lines 1-16, col 4, lines 35-67, col 5, lines 1-67, col 6, lines 1-20, col 7-8).

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 14, 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over DIRE ET AL or MARGOLIN or KRAVITZ ET AL in view of LEAKE (US 5,624,119).

DIRE ET AL / MARGOLIN or KRAVITZ ET AL as advanced meet all the limitation as set forth above except for the use of wild ball. LEAKE discloses such above the use of one or

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more wild balls and it functions as defined in column 14 through 16 (col 14, lines 50-67, col 15, lines 1-67, col 16, lines 1-13). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize with the random selection apparatus in particular the wild balls as taught by LEAKE in combination with the apparatus and process of DIRE ET AL in order to facilitate the probability controls and extended play benefits as so to provide the greatest entertainment value and player attraction possible by using the available methods.

### *Conclusion*

15. Official documents related to the instant application may be submitted to the Technology Center 3700 mail center by facsimile at (703) 305-3579/3580. Should Applicant desire to submit a DRAFT response to the Examiner by facsimile transmission, then Applicant should contact the Examiner at the number below for instructions concerning the transmission of DRAFT documents. Applicant is reminded to clearly mark any facsimile transmission as "DRAFT" if it is not to be considered as an official response.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887.



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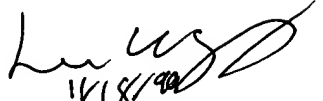
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17. Any inquiry of general nature or relating to the status of this application should be directed to the group of receptionist at (703) 308-1148.

mt.

November 11, 1999

  
11/18/99  
LEE YOUNG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700